

REMARKS

With this Amendment, Applicant adds new claims 31-40 and amends claim 20. No new matter is added. Therefore, claims 1-40 are all the claims currently pending in the present application.

I. Formal Matters

Applicant thanks the Examiner for acknowledging the claim to foreign priority and for confirming that the certified copy of the priority document was received.

Applicant respectfully requests the Examiner to indicate whether the drawings filed April 18, 2001 are approved.

II. Rejection of Claims 1-3, 5-8, and 11 Under 35 U.S.C. § 102(a)

Claims 1-3 and 5-8 stand rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Eckhoff (Jean Eckhoff, Convenience Stores News, **News Briefs**, Jan. 10, 2000, v36, n1, p14; hereinafter "Eckhoff"). Claim 1 recites:

An image display method, comprising the steps of:
extracting a person in a photographed image;
detecting a first characteristic of said extracted person; and
switching an image displayed on an image display medium in accordance with
the first characteristic of said extracted person.

Applicant respectfully submits that Eckhoff fails to disclose or suggest at least an image display method, comprising, *inter alia*, switching an image displayed on an image display medium in accordance with the first characteristic of said extracted person. In the Office Action, the Examiner alleges that Eckhoff teaches all of the features of claim 1. (*See* pgs. 2 and 3 of the Office Action). Contrary to the Examiner's allegations, there is simply no disclosure in Eckhoff

suggesting switching an image displayed on an image display medium in accordance with the first characteristic of said extracted person, as claimed.

Rather, Eckhoff is directed to a biometric face-recognition system which utilizes face-recognition cash machines (i.e., Rapid Pay Machines) “to authenticate customers, thereby reducing risk of fraud.” According to the disclosure of Eckhoff, the face-recognition cash machines feature a multimedia “screen that can be customized to deliver promotional, advertising or a public-service message.” In rejecting claim 1, the Examiner asserts that Eckhoff teaches that “targeted” advertising is switched on the multimedia screen in accordance with “the features/shape of the [customer’s] face.” (*See* pg. 2 of the Office Action). Eckhoff, however, is simply silent regarding the manner in which advertising is displayed on the multimedia screen disclosed therein.

Even assuming *arguendo* that advertising is switched on the multimedia screen disclosed by Eckhoff, there is nothing to indicate that the advertising is switched in accordance with a detected first characteristic of said extracted person, as claimed. In fact, there exists a wide range of situations where advertising may be switched on the multimedia screen taught by Eckhoff, which are not based on a detected first characteristic of said extracted person. For example, the customized advertising could be switched based on a time of day or location of the cash machine. The customization need not be relative to extractions from an image as claimed. In other words, the scheme disclosed by Eckhoff does not necessarily teach that advertising is switched in accordance with the first characteristic of said extracted person, as required by claim 1.

Moreover, evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”¹ “Inherency, however may not be established by probabilities or possibilities.” (See MPEP § 2112) (emphasis added). The mere “fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (See *id.*) (emphasis added). Therefore, any arguments by the Examiner which rely on inherent disclosure of switching advertising in accordance with the first characteristic of said extracted person is not sufficient to support an anticipation rejection because there may be a number of ways in which a person skilled in the art could switch advertising on a multimedia screen which do not require features described by claim 1.

Since there is no disclosure in Eckhoff suggesting switching an image displayed on an image display medium in accordance with the first characteristic of said extracted person, and given that this feature is not inherently disclosed by Eckhoff, Applicant respectfully requests the Examiner to reconsider and withdraw the § 102(a) rejection of claim 1.

Regarding claims 2-15, which depend from claim 1, Applicant submits that claims 2-15 are patentable for at least the reasons submitted for claim 1.

With further regard to claim 3, Applicant submits that claim 3 recites independently patentable subject matter. Specifically, claim 3 recites, *inter alia*, an image display method, comprising the steps of, estimating a *second characteristic* of said extracted person as a customer

¹ Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added).

from said first characteristic, and switching an image displayed on said image display medium in accordance with said *second characteristic* as the customer. According to MPEP § 2131, “[a] claim is anticipated only if each and every element ... set forth in the claim is found, either *expressly or inherently ... in a single prior art reference.*” (emphasis added).

In rejecting claim 3, the Examiner seems to posit that Eckhoff inherently teaches estimating a second characteristic of said extracted person as a customer from said first characteristic. (See pg. 3 of the Office Action). Here, the Examiner has not provided the basis in fact or the technical reasoning to reasonably support the determination that Eckhoff inherently teaches estimating a second characteristic of said extracted person as a customer from said first characteristic, and switching an image displayed on said image medium in accordance with said estimated second characteristic as the customer, as claimed. To be precise, the Examiner’s assertion that “targeted customized ads to users is taken to *inherently* include estimation of a characteristic such as ‘this person would likely be receptive to this selected ad,’”² does not demonstrate that the features recited in claim 3 are necessarily present in the Eckhoff disclosure. As discussed above with respect to claim 1, a skilled artisan could simply manipulate the advertising system in Eckhoff such that it switches advertising displayed on the multimedia screen based solely on geographic criteria or temporal criteria. Given this alternative for displaying advertising on the multimedia screen (taught by Eckhoff), the features of claim 3 do not necessarily flow from the teachings of the Eckhoff disclosure.

² See pg. 3 of the Office Action. (emphasis added).

Additionally, there is no express disclosure in Eckhoff suggesting estimating a second characteristic of said extracted person as a customer from said first characteristic, and switching an image displayed on said image display medium in accordance with said estimated second characteristic as the customer, as required by claim 3. Since all of the features of claim 3 are not taught by Eckhoff, Applicant submits that Eckhoff does not anticipate claim 3 and Applicant respectfully requests the Examiner to reconsider and withdraw the § 102(a) rejection of claim 3 for this additional reason.

With respect to claim 5, Applicant submits that claim 5 recites independently patentable subject matter in that the cited prior art fails to disclose or suggest at least an image display method, wherein priority in accordance with said second characteristic is set to said image displayed by switching, as required by claim 5. In rejecting claim 5, the Examiner asserts that Eckhoff teaches the features of claim 5 since “the ad selected for display to the user is taken to be a higher priority ad than other, non-displayed ads.” (*See* pg. 3 of the Office Action). Contrary to the assertion of the Examiner, there is simply no disclosure in Eckhoff and the Examiner cites to none suggesting an image display method, wherein priority in accordance with said second characteristic is set to said image displayed by switching, as required by claim 5. Given that Eckhoff does not teach each and every element of claim 5, Applicant respectfully requests the Examiner to reconsider and withdraw the § 102(a) rejection of claim 5 for this additional reason.

With further regard to claim 7, Applicant submits that Eckhoff fails to disclose or suggest at least an image display method, wherein said photographed image is a photographed image of a person who uses a game machine, and wherein said image display apparatus is the one for

displaying contents of a game in said game machine, as required by claim 7. In rejecting claim 7, the Examiner asserts that the face-recognition cash machines taught by Eckhoff “could be considered a game apparatus where the game played by the user is ‘what the heck is my pin number again?’” (See pg. 3 of the Office Action).

As mentioned above, “[a] claim is anticipated only if each and every element ... set forth in the claim is found, either expressly or inherently ... in a single prior art reference.” (See MPEP § 2131). Since Eckhoff merely relates to a “biometric face-recognition system” which uses “face-recognition cash machines [to] authenticate customers,” Eckhoff does not disclose or suggest a game machine. Accordingly, Eckhoff does not expressly disclose, suggest, or otherwise teach, an image display method, wherein said photographed image is a photographed image of a person who uses a game machine, and wherein said image display apparatus is the one for displaying contents of a game in said game machine, as required by claim 7. Because Eckhoff does not teach each and every element of claim 7, Applicant respectfully requests the Examiner to reconsider and withdraw the § 102(a) rejection of claim 7 for this additional reason.

With further regard to claim 8, Applicant respectfully submits that claim 8 is believed to recite independently patentable subject matter given that the cited prior art fails to disclose or suggest at least an image display method, wherein an image displayed by said image display apparatus includes an advertisement associated with said game or a character appeared in said game, as claimed. In the Office Action, the Examiner appears to reject claim 8 for the same reasons submitted for claim 7. As discussed above, with respect to claim 7, Eckhoff does not disclose, suggest or otherwise teach a game machine. Thus, Eckhoff does not expressly or inherently teach an image display method, wherein an image displayed by said image display

apparatus includes an advertisement *associated with said game or a character appeared in said game*, as required by claim 8. Since Eckhoff does not teach all of the features of claim 8, Applicant respectfully requests the Examiner to reconsider and withdraw the § 102(a) rejection of claim 8 for this additional reason.

III. Rejection of Claims 4, and 9-10 Under 35 U.S.C. § 103(a) over Eckhoff

The Examiner rejected claims 4, and 9-10 under 35 U.S.C. § 103(a) as being unpatentable over Eckhoff. Applicant respectfully traverses this rejection for the following reasons.

Since claim 4 depends from claim 1, Applicant submits that claim 4 is patentable for at least the reasons submitted for claim 1. Further, Applicant submits that claim 4 is independently patentable given that the cited prior art fails to teach, suggest, or provide motivation for an image display method, wherein said second characteristic is at least one of gender, age, and occupation, as required by claim 4.

In the Office Action, the Examiner has not addressed how Eckhoff teaches, suggests, or provides motivation for an image display method, wherein said second characteristic is at least one of gender, age, and occupation, in combination with other elements of the of the claims. In rejecting claim 4, the Examiner takes Official Notice that the features of claim 4 were well known to those of ordinary skill in the art at the time of the invention. (*See* pg. 3 of the Office Action). Applicant submits that the Examiner's position with respect to Official Notice is not sustainable because the elements of claim 4, in combination with claims 1 and 3, are points of novelty that are patentable.

The MPEP, in § 2144.03 E, which provides guidance for the Examiner in such matters, states:

[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art *without documentary evidence* to support the [E]xaminer's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to “fill in the gaps” *in an insubstantial manner* which might exist in the evidentiary showing made by the [E]xaminer to support a particular ground for rejection. *It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence* upon which a rejection was based. *See Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. (emphasis added)

In view of the mandate set forth above, Applicant respectfully requests the Examiner to withdraw the § 103(a) rejection of claim 4 or provide prior art which substantiates the claim that the claimed combination of elements that are included in claim 4 were well known at the time of the invention so as to render claim 4 obvious.

Regarding claim 9, Applicant submits that claim 9 is patentable for at least the reasons submitted for claim 1. In addition, Applicant submits that claim 9 is independently patentable because Eckhoff fails to teach, suggest, or provide the motivation for an image display method, wherein said photographed image is a photographed image of a person who watches television, and wherein said image display apparatus is the one for displaying a television program, as claimed. At best, Eckhoff merely discloses that advertising is displayed on a “multimedia second screen” when a customer is identified by a “face-recognition machine.” As such, Eckhoff makes no suggestion or motivation for the claim limitation “wherein said photographed image is a photographed image of a person who watches television,” as required by claim 9.

In rejecting claim 9, the Examiner asserts that “any type of well known display such as a television monitor [provided] with the system of Eckhoff” would render claim 9 obvious. (*See*

pg. 4 of the Office Action). Assuming *arguendo* that a television monitor could be used with the “face-recognition system” taught by Eckhoff, the Examiner has not shown how such a combination provides the motivation for the claim limitation “wherein said photographed image is a photographed image of a person who watches television.” Since the features of claim 9 in combination with claims 1 and 6, are additional aspects of novelty, Applicant respectfully requests the Examiner to withdraw the § 103 (a) rejection of claim 9 or provide prior art that substantiates the claim that the features recited in claim 9 were well known and old in the art.

With further regard to claim 10, Applicant submits that claim 10 is patentable for at least the reasons submitted for independent claim 1 and claim 9.

IV. Rejection of Claims 12-15, and 20-23 Under 35 U.S.C. § 103(a) over Eckhoff in view of Fridman

Claims 12-15, and 20-23 stand rejected as being unpatentable over Eckhoff in view of Fridman (Sherman Fridman, Bans Eye Iris Scan Identification Technology, *Newsbytes*, Dec. 9, 1999; hereinafter “Fridman”). Applicant respectfully traverses this rejection for the following reasons.

With regards to claims 12-15, Applicant submits that claims 12-15 are patentable for at least the reasons submitted for independent claim 1 and because Fridman fails to make up for the deficiencies of Eckhoff.

In addition to its dependency from claim 1, Applicant submits that claim 15 recites independently patentable subject matter because Eckhoff, Fridman, or a combination thereof fails to teach, suggest or provide the motivation for an image display method, wherein switching an image displayed on said hardcopy image display medium is at least one of changing a

background, changing a synthesized character and changing contents of image processing to be executed on the displayed image, as required by claim 15. In rejecting claim 15, the Examiner seems to allege that the combination of Eckhoff and Fridman teaches all of the features of claim 15. Particularly, the Examiner asserts that Fridman teaches switching a “hard copy (mail)” of different advertising “for one person vs. another person.” (*See* pg. 5 of the Office Action).

Assuming *arguendo*, that Fridman discloses switching a hard copy “for one person vs. another person” as asserted by the Examiner, there is simply no disclosure in Fridman and Eckhoff and the Examiner cites to none suggesting wherein switching an image displayed on said hardcopy image display medium *is at least one of changing a background, changing a synthesized character and changing contents of image processing to be executed on the displayed image*, as required by claim 15.

Since neither Eckhoff, Fridman nor any combination thereof teaches all of the limitations of claim 15, Applicant respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 15 for this additional reason.

Regarding claim 20, Applicant submits that claim 20 is patentable because Eckhoff, Fridman or a combination thereof fails to teach, suggest, or provide the motivation for at least an image display method, comprising, *inter alia*, switching an image displayed on an image display medium in accordance with an individual subjected to said person identification when it is decided that the display of said image is prohibited, as claimed. In the Office Action, the Examiner asserts that the combination of Eckhoff and Fridman teaches all of the features of claim 20. (*See* pg. 4 of the Office Action). Contrary to the assertion of the Examiner, there

simply is no disclosure in Eckhoff and Fridman suggesting all of the features of claim 20, as amended.

As discussed above, Eckhoff is directed to a “biometric face-recognition system” which utilizes face-recognition cash machines “to authenticate customers, thereby reducing risk of fraud.” The face-recognition cash machines taught by Eckhoff feature a multimedia “screen that can be customized to deliver promotional, advertising or a public-service message” to an identified customer. Nowhere in Eckhoff is there any disclosure suggesting switching an image displayed on an image display medium in accordance with an individual subjected to said person identification *when it is decided that the display of said image is prohibited*, as claimed.

Accordingly, Eckhoff does not teach all of the features required by claim 20.

Similarly, Fridman fails to teach or suggest the features of claim 20. For instance, Fridman merely relates generally to a system of iris identification “which [uses] standard video cameras and real-time processing to acquire a picture of a person’s iris” so that a customer of a bank can be identified at a walk up teller station. In particular, Fridman teaches that the picture of the customer’s iris is digitally encoded and compared with a picture on file with the bank in order to verify the customer’s identification. According to the disclosure of Fridman, the customer’s personal profile could then be displayed and targeted advertisements could be delivered to the customer on a screen, for example. Given that Fridman merely teaches identifying a customer with an iris identification system and displaying targeted advertisements to the customer based on the customer’s personal profile, Fridman does not disclose, suggest, or otherwise teach at least an image display method, comprising, *inter alia*, switching an image displayed on an image display medium in accordance with an individual subjected to said person

identification when it is decided that the display of said image is prohibited, as required by claim 20.

Because neither Eckhoff, Fridman, nor any combination thereof teaches or suggests all of the limitations of claim 20, Applicant respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 20.

Concerning claims 21-23, Applicant submits that claims 21-23 are patentable for the reasons submitted for independent claim 20 and because Fridman fails to make up for the deficiencies of Eckhoff. Further, Applicant respectfully submits that claim 22 is independently patentable because Eckhoff, Fridman, or a combination thereof fails to teach, suggest, or provide the motivation for an image display method, wherein said image is switched and displayed based on priority corresponding to each individual, as required by claim 22. In the Office Action, the Examiner suggests that the cited prior art teaches all of the features of claim 22 given that “[t]he ad selected for display to the user is taken to be a higher priority ad than other, non-displayed ads.” (*See* pg. 4 of the Office Action). Quite the opposite, there simply is no disclosure in Eckhoff and Fridman and the Examiner cites to none suggesting an image display method, wherein said image is switched and displayed based on priority corresponding to each individual, as required by claim 22. The order or priority of display in Eckhoff and Fridman can be based on characteristics independent of the person.

Since, neither Eckhoff, Fridman, nor any combination thereof teaches or suggests the features of claim 22, Applicant respectfully requests the Examiner to reconsider and withdraw the 103(a) rejection of claim 22 for this additional reason.

V. New Claims

Applicant has added new claims 31-40 in order to more fully cover various aspects of Applicant's invention as disclosed in the specification. In addition to their dependencies from claims 1 and 20, Applicant respectfully submits that claims 31-40 should be allowable because the cited prior art does not teach or suggest the limitations of these claims.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Susan Perng Pan
Registration No. 41,239

Date: April 28, 2005